IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of

CALAWAY et al. Atty. Ref.: 4830-3 (AMK)

Serial No. 09/814,441 TC/A.U.: 3625

Filed: March 22, 2001 Examiner: M. Gart

For: ELECTRONIC STORAGE MEDIUM AND PURCHASING SYSTEM AND METHOD

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February 19, 2008

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Sir:

Appellants hereby **appeal** to the Board of Patent Appeals and Interferences from the last decision of the Examiner.

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(I) REAL PARTY IN INTEREST

The real party in interest is Tri Ventures Inc., a corporation of Georgia.

(II) RELATED APPEALS AND INTERFERENCES

The Appellants, the undersigned, and the assignee are not aware of any related appeals, interferences, or judicial proceedings (past or present), which will directly affect or be directly affected by or have a bearing on the Board's decision in this Appeal.

(III) STATUS OF CLAIMS

Claims 1-7, 9-13, 15, 18-25, 27 and 29-33 are on appeal in the present application. Claims 8, 14, 16, 17, 26 and 28 have been canceled. All of the pending claims have been rejected. No claims have been substantively allowed.

(IV) STATUS OF AMENDMENTS

No amendments have been filed since the date of the Final Rejection.

(V) SUMMARY OF CLAIMED SUBJECT MATTER

The invention relates to systems and methods for viewing and selecting images from a storage medium and enabling purchasing of products depicted on a storage medium without requiring access to the internet. The method of using the system as illustrated in the flowchart of Fig. 1A, and a schematic block diagram of the system is illustrated in Fig. 1B.

With reference to Fig. 1B, in addition to a storage medium, the system 10 includes a computer 14, which in turn includes a processor 16 and a storage device 18. A storage medium drive 20 and a modem 22 together with the storage device 18 are in electronic communication with the processor 16. The system also includes a display device 26, a keyboard 28, a pointing device 30 and a printer 32. See page 5, lines 1-9.

In order to electronically initiate a purchase of an item 92, a user inserts the storage medium, such as a CD-ROM 12, into the disc drive 20. The processor 16 accesses the CD-ROM 12, and a menu screen 40 appears (see Fig. 3) having a plurality of selections 41-46 from which to choose. See page 5, lines 10-16.

Selecting the exemplary "image gallery" choice 43 from the menu screen 40 brings up a screen 53 with a plurality of images 54-57 thereon from which may be chosen one or more for purchase by selecting them on the screen with the pointing device 30 (see Fig. 6). Each image has associated therewith electronic identifier data. Alternatively, a second image screen 59 (see Fig. 7) is available by selecting button 58 to view a larger version 60 of an image, or the set may be scrolled through 61 (see Fig. 7). See page 6, lines 8-14.

If the user wishes to purchase an item, the user selects one of the items from the screen with the pointing device 30, and a "shopping cart" area 68 is updated by the software. When shopping is complete, the order form 69 is brought up (see Fig. 9), which can be completed by the user with customary ordering information. The form also lists the selected items in a total cost. See page 6, line 20 – page 7, line 5.

If the user does not wish to place the order immediately, the system 10 stores the order form data 69 on the user's computer 14, where it may reside until the user calls it up for processing by outputting the order form data 69 to the vendor 90, who will then ship the selected items 92 to the user 94. The order form may be output in any of a number of media; for example, the screen 69 itself may be used by the user 94 to place a telephone call to the vendor 90 and place an order; or the screen 69 may be printed on the printer 32 and mailed or faxed to the vendor 90. See page 7, lines 6-13.

With this system and methodology, viewing, selecting and purchasing are much faster than previously known methods since no simultaneous connection to the Internet is required while shopping. See page 7, lines 14-16.

The system may also include a reminder function that prompts the user at startup that a pending order remains on the computer. See page 7, lines 16-18.

Specific Support for Independent Claims

1. A method for electronically initiating a purchase of an item using a computer, the method comprising the steps of':

providing a data storage medium having at least one image of at least one item stored thereon; [page 5, lines 10-14 and page 8, lines 6-9]

accessing an image of an item from the storage medium; [page 6, lines 8-19]

viewing the accessed item image on a display in communication with a local processor; [page 6, lines 8-19]

electronically selecting the item for purchase, causing purchase data on the item to be stored on a writable memory device in communication with the local processor, wherein all purchase data not supplied by a consumer is supplied by the data storage medium such that the purchase data is compiled entirely without Internet access, the purchase data being sufficient to complete the purchase of the item; [page 6, line 20 – page 7, line 5 and page 8, lines 12-16]

permitting a first selection and a second selection, wherein

the first selection causes printing of an order form containing the purchase data and configured to initiate a purchase when physically delivered to a vendor, and wherein

the second selection causes storing of the purchase data on a device accessible by the local processor; and [page 7, lines 6-13 and page 8, lines 17-20]

initiating and completing the purchase of the item without accessing the Internet. [page 7, lines 6-18]

12 A method for assisting a buyer to make a purchase from items having images thereof stored on a data storage medium, the method comprising the steps of:

providing a software application on the storage medium, the software adapted to:

run on a local computer comprising a processor and a storage device, an input device, and a display device in electronic communication with the processor, [page 5, lines 10-14 and page 8, lines 6-9

display a menu on the display device comprising identifiers of the images; [page 6, lines 8-19]

receive a selection by a by a user through the input device of an identifier, [page 6, lines 8-14]

write a file on the storage device comprising the selected identifier; [page 7, lines 6-8]

receive a selection by a user through the input device whether to initiate a printing of an order form configured to mediate purchase of an item represented by the identifier electronically when mailed to a vendor, wherein all purchase data and images related to the selected identifier are resident on the storage medium such that the purchase data is compiled entirely without Internet access, the purchase data being sufficient to complete the purchase of the item, wherein the order form is printed with the purchase data; [page 7, lines 6-18]

interfacing the storage medium with the processor; and [page 7, lines 6-9]

initiating and completing the purchase of the item without accessing the Internet. [page 7, lines 6-18]

15. A system for electronically initiating a purchase of an item using a computer, the system comprising:

a removable electronic storage medium having at least one three-dimensional image of at least one item and a software application stored thereon; [page 5, lines 10-14, page 6, lines 15-19, and page 8, lines 6-9]

a local processor, [page 5, lines 1-4]

a storage device, means for reading data from the storage medium, an input device, and a display device, all in electronic communication with the local processor, [page 5, lines 1-9]

wherein the software application is adapted to:

run on the local processor; [page 5, lines 13-15]

display a menu on the display device comprising identifiers of the images; [page 6, lines 8-19]

receive a selection of an identifier by a user through the input device; [page 6, lines 8-14 and line 21-22]

write a file on the storage device comprising the selected identifier; [page 7, lines 1-9]

access an image of an item from the storage medium, wherein the image is a three-dimensional image; [page 6, lines 8-19]

display the accessed item three-dimensional image on the display device; [page 6, lines 8-11]

permit the user to selectably rotate the three-dimensional image about a user defined axis of rotation; [page 6, lines 17-19]

receive a user selection of the item for purchase; [page 6, line 20 – page 7, line 1]

automatically store purchase data on the item on a writable memory device in communication with the local processor such that the purchase data is compiled entirely without Internet access, the purchase data being sufficient to complete the purchase of the item; and [page 7, lines 6-18]

permitting a first selection and a second selection, wherein

the first selection causes printing of an order form containing the purchase data and configured to initiate a purchase when physically delivered to a vendor; and wherein

the second selection causes storing of the purchase data on a device accessible by the local processor; and [page 7, lines 6-13 and page 8, lines 17-20]

a communication device that initiates and completes the purchase of the item without accessing the Internet. [page 7, lines 9-18]

19. A software application resident on a storage medium also containing digital representations of a plurality of visual images and purchasing data for items associated with at least some of the images, the software application comprising:

means for interfacing with a local processor; [page 5, lines 10-14 and page 8, lines 6-9]

means for displaying three-dimensional visual images of at least some of the items on a display device in communication with the local processor, wherein the three-

dimensional visual images may be selectably rotated about a first axis by a user, thereby displaying different aspects of the items; [page 6, lines 8-19]

means for receiving a selection of an item from a user through an input device in electronic communication with the local processor; [page 6, lines 8-14 and line 21-22]

means for writing a file on a storage device in electronic communication with the local processor comprising the selected item and associated purchasing data, the purchasing data being compiled entirely without Internet access, the purchasing data being sufficient to complete the purchase of the item; [page 7, lines 6-18]

means for, if purchasing data have been stored, selectably establishing a communication link to a remote vendor for order processing without accessing the Internet; and [page 7, lines 6-18]

means for selectably storing the purchasing data on a device accessible by the local processor. [page 7, lines 6-9]

(VI) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether claims 1-4, 7-15, 18-25, 27, 30 and 32 are unpatentable under 35 U.S.C. §103(a) over U.S. Published Patent Application No. 2001/0037373 to Cambridge in view of U.S. Published Patent Application No. 2002/0026374 to Moneymaker.

2. Whether claims 5 and 6 are unpatentable under 35 U.S.C. §103(a) over Cambridge in view of Moneymaker and U.S. Patent No. 6,026,376 to Kenney.

3. Whether claims 29, 31 and 33 are unpatentable under 35 U.S.C. §103(a) over Cambridge in view of Moneymaker and U.S. Patent No. 5,918,213 to Bernard et al.

(VII) ARGUMENT

At the outset, Appellants note that the grounds of rejection in the final Office Action dated September 25, 2007 are *identical* to those in the Office Action dated May 22, 2007. The Examiner did not address Appellants' arguments in the Request for Reconsideration filed August 21, 2007, however, stating that the arguments are "moot in view of the new grounds of rejection." With a proper response to Appellants' arguments, Appellants could have addressed any oversights or misunderstandings by the Examiner in the Appeal Brief.

Appellants reserve the right to submit additional or revised arguments in a Reply Brief to address the Examiner's response to the arguments below.

1. Claims 1-4, 7-15, 18-25, 27, 30 and 32 are not unpatentable under 35 U.S.C. §103(a) over U.S. Published Patent Application No. 2001/0037373 to Cambridge in view of U.S. Published Patent Application No. 2002/0026374 to Moneymaker.

An important objective of the present invention is to facilitate a product purchase using a computer but without requiring access to the Internet. The Office Action recognizes that the Cambridge publication requires access to the Internet in order to initiate and complete a purchase. In this context, the Office Action references Moneymaker at paragraph [0027] describing that payment may be effected offline, and the Office Action concludes that it would have been obvious to modify the Cambridge system to include such offline payment.

With reference to the claims, however, claim 1 defines a step of initiating and completing the purchase of the item without accessing the Internet. The reference in Moneymaker to enable offline payment does not correct the deficiencies noted with

regard to the Cambridge publication. That is, even though the Moneymaker publication references an offline payment, the Moneymaker system is not operable without online access. In fact, every item of information necessary to initiate and complete an order requires Internet access. See, e.g., paragraph [0027].

Reference to an offline payment without considering the remaining disclosure is insufficient to support an obviousness conclusion. It is well settled that "it is impermissible within the framework of §103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." See, *In re Kamm*, 172 USPQ 298 (CCPA 1972), citing *In re Rothermel*, 125 USPQ 328 (CCPA 1960). The mere reference to an offline payment option when every other function/operation in the Moneymaker system requires Internet access does not provide a requisite teaching to support the obviousness determination. The resulting hindsight conclusion is improper, and Appellants thus respectfully submit that the rejection of claim 1 is misplaced.

Claim 12 defines related subject matter, and claim 15 defines a communication device that initiates and completes the purchase of the item without accessing the Internet. Claim 19 recites means for, if purchasing data have been stored, selectably establishing a communication link to a remote vendor for order processing without accessing the Internet. For reasons similar to those discussed above with regard to claim 1, Appellants respectfully submit that the rejection of these independent claims is also misplaced.

With regard to the dependent claims, Appellants submit that these claims are allowable at least by virtue of their dependency on an allowable independent claim.

Reversal of the rejection is respectfully requested.

2. Claims 5 and 6 are not unpatentable under 35 U.S.C. §103(a) over Cambridge in view of Moneymaker and U.S. Patent No. 6,026,376 to Kenney.

Appellants respectfully submit that the Kenney patent does not correct the deficiencies noted above with regard to Cambridge and Moneymaker, taken singly or in combination. As such, Appellants submit that these dependent claims are allowable at least by virtue of their dependency on an allowable independent claim. Reversal of the rejection is respectfully requested.

3. Claims 29, 31 and 33 are not unpatentable under 35 U.S.C. §103(a) over Cambridge in view of Moneymaker and U.S. Patent No. 5,918,213 to Bernard et al.

Appellants respectfully submit that the Bernard patent does not correct the deficiencies noted above with regard to Cambridge and Moneymaker, taken singly or in combination. As such, Appellants submit that these dependent claims are allowable at least by virtue of their dependency on an allowable independent claim. Reversal of the rejection is respectfully requested.

CONCLUSION

In conclusion it is believed that the application is in clear condition for allowance; therefore, early reversal of the Final Rejection and passage of the subject application to issue are earnestly solicited.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: /Alan M. Kagen/
Alan M. Kagen
Reg. No. 36,178

AMK:jls
901 North Glebe Road, 11th Floor
Arlington, VA 22203-1808
Telephone: (703) 816-4000
Facsimile: (703) 816-4100

(VIII) CLAIMS APPENDIX

1. A method for electronically initiating a purchase of an item using a computer, the method comprising the steps of':

providing a data storage medium having at least one image of at least one item stored thereon;

accessing an image of an item from the storage medium;

viewing the accessed item image on a display in communication with a local processor;

electronically selecting the item for purchase, causing purchase data on the item to be stored on a writable memory device in communication with the local processor, wherein all purchase data not supplied by a consumer is supplied by the data storage medium such that the purchase data is compiled entirely without Internet access, the purchase data being sufficient to complete the purchase of the item;

permitting a first selection and a second selection, wherein

the first selection causes printing of an order form containing the purchase data and configured to initiate a purchase when physically delivered to a vendor, and wherein

the second selection causes storing of the purchase data on a device accessible by the local processor; and

initiating and completing the purchase of the item without accessing the Internet.

2. The method in Claim 1, wherein:

at least one image comprises a three dimensional image; and

the viewing step comprises permitting a user to selectably rotate the image in at least one dimension between a first aspect and a second aspect.

3. The method recited in Claim 1, wherein the at least one image comprises two sets of images, a first set comprising an image of an object and a second set comprising an image of a saleable item related to the object.

4. The method recited in Claim 1, wherein the storage medium is selected from a group consisting of a read-only memory disk and a read-write disk.

5. The method recited in Claim 1, wherein the item image further comprises an electronic switch means activatable with an input device in communication with the processor for enabling the selection step.

6. The method recited in Claim 5, wherein:

the e1ectronic switch means comprises a defined region on the disp1ay; and

the electronic selection step comprises using input means for pointing at and selecting the button.

7. The method recited in Claim 1, wherein the viewing step is completed without having accessed information related to the item not already contained by the removable data storage medium.

9. The method recited in Claim 1, further comprising the step, following the electronic selection step, of viewing the purchase data formatted as an order form.

10. The method recited in Claim 9, further comprising the step, following the purchase data viewing step, of revising an item of the purchase data to update the purchase data.

11. The method recited in Claim 1, further comprising the step of offering a plurality of choices of material for display, including a virtual-reality tour of a site, a set of still images, and promotional information.

12 A method for assisting a buyer to make a purchase from items having images thereof stored on a data storage medium, the method comprising the steps of:

providing a software application on the storage medium, the software adapted to:

run on a local computer comprising a processor and a storage device, an input device, and a display device in electronic communication with the processor,

display a menu on the display device comprising identifiers of the images;

receive a selection by a by a user through the input device of an identifier,

write a file on the storage device comprising the selected identifier;

receive a selection by a user through the input device whether to initiate a printing of an order form configured to mediate purchase of an item represented by the identifier electronically when mailed to a vendor, wherein all purchase data and images related to the selected identifier are resident on the storage medium such that the purchase data is compiled entirely without Internet access, the purchase data being sufficient to complete the purchase of the item, wherein the order form is printed with the purchase data;

interfacing the storage medium with the processor; and

initiating and completing the purchase of the item without accessing the Internet.

13. The method recited in Claim 12, wherein the software is further adapted to retrieve the identifier from the storage device and display the identifier on the display device.

15. A system for electronically initiating a purchase of an item using a computer, the system comprising:

a removable electronic storage medium having at least one three-dimensional image of at least one item and a software application stored thereon;

a local processor,

a storage device, means for reading data from the storage medium, an input device, and a display device, all in electronic communication with the local processor,

wherein the software application is adapted to:

run on the local processor;

display a menu on the display device comprising identifiers of the images;

receive a selection of an identifier by a user through the input device;

write a file on the storage device comprising the selected identifier;

access an image of an item from the storage medium, wherein the image is a three-dimensional image;

display the accessed item three-dimensional image on the display device;

permit the user to selectably rotate the three-dimensional image about a user defined axis of rotation;

receive a user selection of the item for purchase;

automatically store purchase data on the item on a writable memory device in communication with the local processor such that the purchase data is compiled entirely without Internet access, the purchase data being sufficient to complete the purchase of the item; and

permitting a first selection and a second selection, wherein

the first selection causes printing of an order form containing the purchase data and configured to initiate a purchase when physically delivered to a vendor; and wherein

the second selection causes storing of the purchase data on a device accessible by the local processor; and

a communication device that initiates and completes the purchase of the item without accessing the Internet.

18. The system recited in Claim 15, further comprising means for outputting a hard copy of the purchase data.

19. A software application resident on a storage medium also containing digital representations of a plurality of visual images and purchasing data for items associated with at least some of the images, the software application comprising:

means for interfacing with a local processor;

means for displaying three-dimensional visual images of at least some of the items on a display device in communication with the local processor, wherein the three-dimensional visual images may be selectably rotated about a first axis by a user, thereby displaying different aspects of the items;

means for receiving a selection of an item from a user through an input device in electronic communication with the local processor;

means for writing a file on a storage device in electronic communication with the local processor comprising the selected item and associated purchasing data, the purchasing data being compiled entirely without Internet access, the purchasing data being sufficient to complete the purchase of the item;

means for, if purchasing data have been stored, selectably establishing a communication link to a remote vendor for order processing without accessing the Internet; and

means for selectably storing the purchasing data on a device accessible by the local processor.

20. The software application in Claim 19, further comprising means for displaying a shopping cart comprising an item identifier and purchasing data associated therewith along with the visual images.

21. The software application in Claim 20, further comprising means for displaying on the display device a complete order form comprising contents of the shopping cart.

22. The software application recited in Claim 21, wherein the communication link is physically printing an order form configured to be physically delivered to the remote vendor.

23. The software application recited in Claim 19, further comprising means for displaying a menu of subsets of visual images and means for receiving a user selection of a subset from the input device, the user selection directing a display of the subset of images.

24. The software application recited in Claim 19, further comprising means for transferring a second software application to the storage device for permitting a subsequent access of the file from the storage device without the storage medium and the processor being in communication.

25. The software application recited in Claim 19, wherein the visual image displaying means further comprises means for displaying at least one three-dimensional form, wherein the three-dimensional form may be selectably rotated about more than one axis by a user.

27. The method recited in Claim 1, further comprising the steps of, if purchase data have been stored, establishing subsequent communication with the vendor and transmitting the purchase data to the vendor for order fulfillment.

29. The method recited in Claim 12, wherein the software is further adapted to, if a selected identifier has been retained, issue a reminder at process startup to the user via the processor that the selected identifier has been retained.

30. The system recited in Claim 15, wherein the software application is further adapted to establish subsequent communication with the vendor and transmitting the purchase data to the vendor for order fulfillment.

31. The system recited in Claim 15, wherein the software is further adapted to, if purchase data have been stored, issue a reminder at processor startup to the user via the processor that the selected identifier has been retained.

32. The software application recited in Claim 19, further comprising means for if purchasing data have been stored, establishing subsequent communication with the vendor and transmitting the purchase data to the vendor for order fulfillment.

33. The software application recited in Claim 19, further comprising means for, if purchasing data have been stored, providing a reminder at processor startup via the processor that pending purchase data remain on the device.

(IX) EVIDENCE APPENDIX

(NOT APPLICABLE)

(X) RELATED PROCEEDINGS APPENDIX

(NOT APPLICABLE)